REMARKS

Claims 68, 138 and 142-186 are pending in the instant application. No amendments have been made to the claims or specification. Accordingly, claims 68, 138 and 142-186 will remain pending in the application. *No new matter has been added.*

Judicially Created Doctrine of Obviousness-Type Double Patenting

Rejection of Claims 68, 138 and 142-186 under Judicially Created Doctrine of Obviousness-Type Double Patenting

Claims 68, 138 and 142-186 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18-19 of U.S. Patent No. 6,306,909. For the sake of convenience, Applicants provide the text of claims 18-19 of U.S. Patent No. 6,306,909 below.

> 18. A method for inhibiting epileptogenesis, comprising administering to a subject in need thereof an effective amount of an anti-epileptogenic agent which is a β-amino acid or an ester or salt thereof, such that epileptogenesis is inhibited in said subject.
>
> 19. A method for inhibiting epileptogenesis, comprising administering to a subject in need thereof an effective amount of an agent such that epileptogenesis is inhibited in said subject by a β-amino acid or an ester or salt thereof.

The Office Action specifically refers to the reasoning of a previous Office Action, which is incorporated by reference. In particular, the instant Office Action makes reference to the Office Action of April 9, 2002 (Paper No. 7), which recites that U.S. Patent No. 6,306,909 "teaches a method of inhibiting epileptogenesis using a β-amino compound...," and that "the instantly recited substituted β-alanine compound is [a] subgenus of the reference compounds."

In this regard, Applicants have provided a terminal disclaimer with respect to U.S. Patent No. 6,306,909, which is enclosed herewith. Applicants submit that the submission of the terminal disclaimer should be sufficient to moot the rejection of claims 68, 138 and 142-186 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18-19 of U.S. Patent No. 6,306,909, to the extent the Examiner is taking the position that the claims 18-19 read on β-amino acid compounds. Accordingly, Applicants respectfully request withdrawal of this rejection.

Provisional Rejection of Claim 68, 138 and 142-153 under Judicially Created Doctrine of Obviousness-Type Double Patenting

Claims 68, 138 and 142-153 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 68-90 of U.S. Application No. 09/932,676. The Office Action asserts that while the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims substantially overlap the reference claims. Moreover, the Office Action states that

> [t]he reference method is drawn to administering compounds having a ***cyclic*** amino group attached to a two carbon spacer carrying an anionic group...[and] one of ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole. (Emphasis added)

Applicants traverse this rejection and respectfully submit that this rejection is improper in light of the Restriction Requirement issued by the United States Patent and Trademark Office in the mutual priority application (from which both applications have been derived as divisional applications). At this point, Applicants make the relevant notation that both the reference application and the present application are divisional applications of U.S. Utility Application 09/041,371 ("Parent Applications"), filed on March 11, 1998, and now issued as U.S. Patent No. 6,306,909.

Applicants specifically invite the Examiner's attention to the Restriction Requirement of the Parent Application (Paper No. 6) mailed from the United States Patent and Trademark Office on April 5, 1999. In particular, Applicants respectfully point out that the subject matter of claims 68-90 of U.S. Application No. 09/932,676 was the subject of claims 64-65 and 67, as well as claim 66, in the Parent Application, which were restricted as Group XII and Group XIII, respectively. Furthermore, in the Office Action of the Parent Application dated August 27, 1999 (Paper No. 10), the Examiner states on page 2 that

> ... the pending claims are drawn to noncyclic and cyclic β-amino acids. They are structurally dissimilar such that a reference anticipating a compound may not render the remaining compounds obvious. ***Note in the instant case, the reference anticipating the compounds according to the elected invention, does not render compounds according to other groups obvious***. (Emphasis added)

Group III was elected by Applicants in the Parent Application, and therefore Groups XII and XIII would be considered as the "other groups," and as such the compounds that fall within the scope of these Groups would not be rendered obvious by the elected Group III (*i.e.*, and therefore the allowed/issued claims of the Parent Application directed thereto would not be rendered obvious). Particularly, the pending claims of the present application are noncyclic, while the claims of the reference application are cyclic β-amino acids. Moreover, the Office Action, by virtue of its own language, has deemed these compounds patentably distinct.

Applicants respectfully point out that it is improper to reject claims under obviousness-type double patenting that were restricted out of a mutual parent application (from which each of the applications are derived as divisional applications of the parent application), and which the Restriction Requirement of the Parent Application, by its own language, states as patentably distinct subject matter. As such, Applicants submit that the provisional rejection of claims 68, 138 and 142-153 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 68-90 of U.S. Application No. 09/932,676 is improper. Accordingly, Applicants request that this rejection be withdrawn.

CONCLUSION

In view of the foregoing remarks presented, favorable reconsideration and withdrawal of the rejections, and allowance of this application with all pending claims are respectfully requested. If a telephone conversation with Applicants' attorney would expedite prosecution of the above-identified application, the Examiner is invited to call the undersigned at (617) 227-7400.

Respectfully submitted,

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Dated: March 30, 2004

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